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JUN 22 2009

OFFICE OF PETITIONS

In re Application of :
Koji Teshima, et al. : DECISION ON APPLICATION
Application No. 10/508,339 : FOR
Filed: October 25, 2004 : PATENT TERM ADJUSTMENT
Atty Docket No. 2004-1514A :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed April 28, 2009. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from four hundred seventy-three (473) days to four hundred seventy-seven(477) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PALM screen to reflect that the Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is **four hundred seventy-seven (477)** days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On January 28, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 473 days. On April 28, 2009, applicants timely submitted the instant application for patent term adjustment¹. Applicants dispute the reduction of 38 days associated with the filing of an amendment on January 15, 2009. Applicants assert that a reduction of only 34 days should be

¹ PALM records indicate that the Issue Payment was also filed on April 28, 2009.

assessed against applicants because a proper reply, in the form of an amendment that *prima facie* places the application in condition for allowance, was filed three months and 34 days after the final Office action of September 12, 2008 was mailed.

The record supports a conclusion that this application is not subject to a terminal disclaimer.

Applicants' arguments have been considered and found persuasive.

A review of the application history reveals that a period of reduction of 34 days should have been entered. 37 CFR 1.704(b) provides, in pertinent part, that:

An applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

A review of the record reveals that a final Office action was mailed on September 12, 2008. Applicants filed an amendment after final on December 8, 2008. The December 8, 2008 amendment did not place the application in *prima facie* condition for allowance. This conclusion is supported by the Examiner Interview Summary Record of January 11, 2009, which states that one of the claims in the December 8, 2008 amendment was not acceptable and that the examiner contacted applicants to suggest a correction and request that applicants submit corrected claims. Applicants filed an amendment correcting the claims on January 15, 2009.

As the December 8, 2008 amendment was not in compliance with § 1.113(c), the period for reply to the final rejection mailed September 12, 2008, continued to run. A proper reply, an

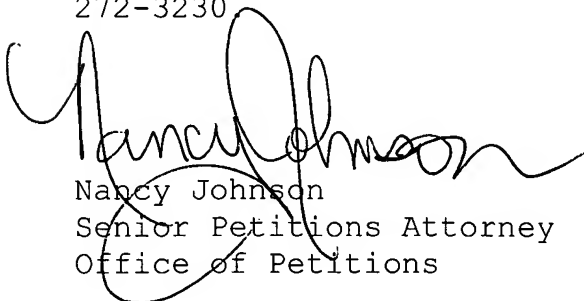
amendment that *prima facie* placed the application in condition for allowance, was not received in the Office until January 15, 2009. Pursuant to § 1.704(b), any patent term adjustment in this application is subject to a reduction of 34 days for applicant delay for the period beginning on December 13, 2008, the day after the date that is three months after the mailing date of the final Office action, and ending on January 15, 2009, the date the reply in compliance with § 1.113(c) was filed. The period of reduction of 38 days previously entered is being removed and a period of reduction of 34 days is being entered for this applicant delay.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is 477 days (575 days of Office delay reduced by 98 days of applicant delay).

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Shirene Willis Brantley at (571) 272-3230.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

PALM INTRANET

Time: 17:04:38

PTA Calculations for Application: 10/508339			
Application Filing Date:	10/25/2004	PTO Delay (PTO):	575
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	102
Post-Issue Petitions:	0	Total PTA (days):	477
PTO Delay Adjustment:	4		

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
61	06/21/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		34	
60	06/21/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	38		
53	02/23/2009	MAIL NOTICE OF ALLOWANCE			
52	01/22/2009	ISSUE REVISION COMPLETED			
51	02/23/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
50	02/23/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
49	01/22/2009	DOCUMENT VERIFICATION			
48	02/23/2009	NOTICE OF ALLOWABILITY			
47	02/23/2009	DATE FORWARDED TO EXAMINER			
46	01/15/2009	SUPPLEMENTAL RESPONSE		38	33
41	01/22/2009	CASE DOCKETED TO EXAMINER IN GAU			
37	01/11/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
36	01/16/2009	DATE FORWARDED TO EXAMINER			
35	01/15/2009	SUPPLEMENTAL RESPONSE			
34	01/05/2009	DATE FORWARDED TO EXAMINER			
33	12/08/2008	AMENDMENT AFTER FINAL REJECTION			
32	09/12/2008	MAIL FINAL REJECTION (PTOL - 326)			
31	09/12/2008	FINAL REJECTION			
30	07/12/2008	DATE FORWARDED TO EXAMINER			
29	06/18/2008	RESPONSE AFTER NON-FINAL ACTION			
28	03/18/2008	MAIL NON-FINAL REJECTION			
27	03/13/2008	NON-FINAL REJECTION			
26	02/06/2008	DATE FORWARDED TO EXAMINER			
25	12/26/2007	RESPONSE AFTER NON-FINAL ACTION		64	23

24	12/26/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
23	07/23/2007	MAIL NON-FINAL REJECTION	575		-1
22	07/17/2007	NON-FINAL REJECTION			
21	07/17/2007	CASE DOCKETED TO EXAMINER IN GAU			
16	05/06/2007	CASE DOCKETED TO EXAMINER IN GAU			
15	10/14/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
14	10/25/2004	MISCELLANEOUS INCOMING LETTER			
10	10/14/2005	CASE DOCKETED TO EXAMINER IN GAU			
9	10/25/2004	REFERENCE CAPTURE ON IDS			
7	02/28/2005	CLEARED BY OIPE CSR			
6	02/18/2005	CLEARED BY OIPE CSR			
5	02/18/2005	CLEARED BY OIPE CSR			
4	10/25/2004	371 COMPLETION DATE			
3	02/08/2005	APPLICATION DISPATCHED FROM OIPE			
2	02/08/2005	NOTICE OF DO/EO ACCEPTANCE MAILED			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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